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MILLENIUM PHARMACEUTICALS, INC.
40 LANDSDOWNE STREET
CAMBRIDGE, MA 02139

In re Application of
Kapeller-Liebermann
Serial No. 10/658,904
Filed : September 10, 2003
Attorney Docket No. : MP100-010P1RCP1M

Decision on Petition

This letter is in response to the Petition under 37 C.F.R. 1.181 filed on June 14, 2006 to withdraw the Finality of the rejection made in the Office communication mailed April 14, 2006.

BACKGROUND

A review of the file history shows that this application was filed under 35 USC 111 and that the Office set forth a restriction requirement under 35 U.S.C. 121, of claims 1-20 in an office action mailed August 1, 2005. The groupings are reproduced below:

Group I, claims 1-4, 9 and 11, drawn to isolated polynucleotides encoding a human kinase, vectors, kits and host cells comprising said polynucleotides and methods of expressing said polynucleotides.

Group II, claims 5-6, drawn to said human kinase and homologs thereof.

Group III, claims 7-8, 10, drawn to antibodies which bind said kinase and kits comprising said antibodies.

Group IV, claims 12, 13, 15, 16, drawn to a method of identifying agents which bind or modulate the activity of said kinase.

Group V, claim 14, drawn to a method of modulating the activity of said kinase.

Group VI, claims 17, 18, drawn to a method of identifying a subject having a disorder such as cancer utilizing DNA sequences encoding said kinase.

Group VII, claim 19, drawn to a method of identifying a subject having a disorder such as cancer utilizing said kinase.

Group VIII, claim 20, drawn to a method of treatment of a patient having a disorder such as cancer using modulators of said kinase.

The Examiner supported this restriction between the DNA of Group I, the kinase of Group II, the antibodies of Group III as patentably distinct since each product is unrelated since they have different and unrelated chemical structures and functions.

The examiner stated that inventions I and VI are related as product as process of use. In the instant case, the DNA of Group I could have been used for recombinant expression of said kinase which is a method totally different than that of Group VI.

Next, the examiner stated that the DNA of Group I and the antibodies of Group III are each unrelated to any of the methods of Groups IV, V, VI because said products are neither made nor used by any such methods.

The examiner also stated that the antibodies of Group III are unrelated to any of the methods of Groups VI and VIII because said product is neither made nor used by any of said methods.

Further, the examiner stated that inventions II and IV (or V) are related as product and process of use. In the instant case, the polypeptides of Group II may be used in antibody preparation which is a totally different method than those of Groups IV or V.

Also, as was presented by the examiner, the polypeptides of Group II are unrelated to any of the methods of Groups VI, VII and VIII because said products are neither used nor made by any of those methods.

Finally, the examiner stated that the methods of Groups IV-VIII are each patentably distinct from one another since each method has different steps and different end points.

Applicants elected Group II, claims 5-6 without traverse in the response filed on September 1, 2005; added claims 21-34; amended claims 5 and 13; and cancelled claims 1-4, 7-11, 14 and 17-20.

In the non-final Office action mailed October 4, 2005, the examiner acknowledged that claims 5, 6 and 21 were allowable. The examiner stated that this was because the expression products of

SEQ ID NO: 1 and 3 are free of the prior art. Further, the examiner said that the prior art does not teach or suggest preparing such specifically claimed products. Hence, the examiner concluded that said products are also non-obvious. Since said products are allowable, the examiner stated, then a fusion product comprising said products is also allowable.

In Applicant's reply filed February 6, 2006, applicant asked for rejoinder of the withdrawn method claims depending from allowed claim 5.

In the Final rejection mailed on April 14, 2006, the examiner indicated that claims 12, 13, 29-34 would not be rejoined since claims 12, 13, 30-34 are directed to methods of use of said isolated polypeptides as well as those in a whole cell, which means that said polypeptides are not isolated.

The petition to review the finality of the Office action mailed April 14, 2006 was filed on June 14, 2006.

DISCUSSION

The application, file history and petition have been considered carefully. In the Petition, Applicants request that the claims of Group IV be rejoined with the claims of Group II or that the rejoinder be reversed and the restriction requirement be reinstated.

Applicants argued that a new restriction requirement was being imposed between a polypeptide inside and outside of the cell. They argued that in the absence of a restriction requirement between polypeptides inside or outside the cell, the rejoinder should have applied to all the claims in the withdrawn group. They concluded that the restriction requirement should not lead to a Final office action and was, therefore, improperly made Final.

Applicants are not correct that the examiner has failed to apply a proper standard for finality in this case. The examiner has correctly established why claims 12, 13, 29-34 were withdrawn from consideration. The reason for withdrawing these claims was correct. **Claims 12, 13, 29-34 are not limited to the allowable product claims**. The examiner correctly continued to hold these claims withdrawn as they clearly encompass polypeptides in a cell which are **not isolated**. Rejoinder of process claims is only applicable if the process claims depend from the allowable product or include all of the claim limitations of the allowed product claims.

For these reasons, claims 5, 6, 21, 27 and 35 remain allowable and claims 12, 13, 29-34 remain withdrawn from further consideration by the examiner since they are not totally limited to the allowable product of claims 5, 6, 21, 27 and 35. Thus, the Final Office action is not withdrawn and stands as is.

DECISION

Applicants petition under 37 CFR 1.181 is **DENIED** for the reasons set forth above.

Claims 5, 6, 21, 27 and 35 remain allowable and claims 12, 13, 29-34 remain withdrawn from further consideration by the examiner since they are not limited to the allowable product of claims 5, 6, 21, 27 and 35.

Applicants remain under obligation to properly reply to the Final Office action mailed April 14, 2006 within the time period set therein or as extended under 1.136 (a).

Should there be any questions regarding this decision, please contact Special Program Examiner Marianne Seidel, by mail addressed to Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at (571) 272-1600 or by Official Fax at 703-872-9306.

Bruce Kisliuk
Director, Technology Center 1600